



UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,750	07/23/2001	Charles M. Patton	10007237-1	4995

7590

11/17/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/911,750	PATTON ET AL.	
	Examiner	Art Unit	
	Zachary A. Davis	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 21-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. An response to the Notice of Non-Compliant Amendment was received on 26 August 2005. By the amendment received 13 June 2005, Claims 1-15, 21, 22, 25, 28, 35-37, 39, 43, and 44 have been amended. Claims 16-20 have been canceled. No new claims have been added. Claims 1-15 and 21-46 are currently pending in the present application.

Response to Arguments

2. Applicant's arguments filed 13 June 2005 have been fully considered but they are not persuasive.

Regarding the rejection of Claims 1-15 under 35 U.S.C. 101 as directed to non-statutory subject matter, Applicant argues that the amendment to the claims, reciting that the valued content is stored in a processor readable medium, overcomes the rejection under 35 U.S.C. 101. The Examiner respectfully disagrees. Although the amendment addresses the first portion of the stated rationale for the rejection, that the content was not tangibly embodied, the amendment has not addressed the second portion of the rationale for the rejection, namely that the claims merely recite non-functional descriptive material. Although the claim recites the valued content in digital form on a "processor readable medium", the content only contains a digital file and a digital string within the file. This is solely an arrangement of data, which constitutes

non-functional descriptive material. Non-functional descriptive material does not become statutory subject matter when it is stored in a computer-readable medium, because it does not provide any functionality. See MPEP § 2106 IV.B.1 and IV.B.1(b).

Regarding the rejection of Claim 44 under 35 U.S.C. 112, second paragraph, as being indefinite, Applicant asserts that the limitation "said purchaser" was not found in the claim. The Examiner respectfully notes that the limitation "said purchaser" appears at the end of line 8 of the presently amended form of Claim 44, as opposed to the limitation "said purchaser processor" appearing in lines 6, 7-8, and 10 of the presently amended form of the claim.

3. Applicant's arguments with respect to the rejections of Claims 1-15, 21-35, and 37-46 under 35 U.S.C. 102(e) as anticipated by Wiser et al, US Patent 6385596, and of Claim 36 under 35 U.S.C. 102(b) as anticipated by Dwork et al, US Patent 6038316, have been considered but are moot in view of the new ground(s) of rejection.

Oath/Declaration

4. The requirement of a statement regarding a post office address is withdrawn.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the

description: 768' (see Figure 7). Although Applicant states that reference character 768' and its associated lead line were among those removed from the drawings, it appears that Applicant overlooked this correction to the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The Examiner notes that the other objections to the drawings as failing to comply with 37 CFR 1.84(p)(4 and 5) have been corrected.

Specification

7. The objection to the disclosure for informalities and errors in the specification is withdrawn. The Examiner thanks Applicant for Applicant's cooperation and careful attention in correcting errors in the specification not specifically noted in the Office action.

Claim Rejections - 35 USC § 101

8. The rejection of Claims 21, 25, 26, and 31-36 under 35 U.S.C. 101 is withdrawn in light of the amendments to the claims.

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-15 are directed merely to an arrangement of data, although stored in a processor readable medium. An arrangement of data is non-functional descriptive material, which is not statutory subject matter even if stored in a computer-readable medium. See MPEP § 2106 IV.B.1 and IV.B.1(b).

Claim Rejections - 35 USC § 112

11. The rejection of Claims 13, 14, 22, 25, 28, and 35-43 under 35 U.S.C. 112, second paragraph is withdrawn in light of the amendments to the claims.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2137

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 44-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 44 recites the limitation "said purchaser" at the end of line 8 of the claim.

There is insufficient antecedent basis for this limitation in the claims.

Claims 45 and 46 are rejected due to their dependence on a rejected base claim.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-15, 21-35, and 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al, US Patent 6385596, in view of Fujiwara, US Patent Application Publication 2001/0054081.

In reference to Claim 1, Wiser discloses valued content in a computer readable-medium including a digital file having independent value to a provider (column 6, lines 48-52) and a digital string having a latent value to a purchaser embedded in a passport that is linked to the digital file (column 8, lines 53-56, where the string is personal information). However, although Wiser discloses that the string is embedded in the

passport linked to the file (column 6, lines 44-46), Wiser does not explicitly disclose also embedding the personal information in the file itself.

Fujiwara discloses a system for content delivery in which personal data is embedded in a delivered digital file (page 4, paragraph 0047; page 5, paragraphs 0049 and 0054). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify the content of Wiser to include the string also embedded directly in the digital file, in order to effectively prevent illegal copying (see Fujiwara, page 5, paragraph 0049).

In reference to Claims 2 and 3, Wiser further discloses that the string is encrypted (column 9, lines 19-20).

In reference to Claim 4, Wiser further discloses the string being embedded in a human perceptible form (column 9, lines 16-18). Fujiwara also discloses the string being embedded in a human perceptible format (page 5, paragraph 0049).

In reference to Claim 5, Wiser further discloses a digital watermark (column 7, lines 5-6 and 17-26).

In reference to Claims 6-9, Wiser further discloses that the file can include text, images (column 6, lines 59-60), and audio (column 6, lines 48-52; column 7, lines 4-9). Fujiwara also discloses that the file can include text, images, and audio (for example, page 6, paragraph 0057).

In reference to Claim 10, Wiser further discloses that the latent value of the string resides in information that would place the purchaser at increased financial risk if known by another (column 8, lines 53-56).

In reference to Claims 11 and 12, Wiser further discloses a provider string that can be encrypted (see column 4, lines 1-4; column 7, lines 27-46; see also column 10, line 60-column 11, line 7).

In reference to Claims 13 and 14, Wiser further discloses recording the file on a portable medium (see column 9, line 53-column 10, line 16).

In reference to Claim 15, Wiser discloses valued content in a computer readable-medium including a digital file having independent value to a provider (column 6, lines 48-52), a digital string having a latent value to a purchaser embedded in a passport that is linked to the digital file (column 8, lines 53-56), and an encrypted provider digital string (see column 4, lines 1-4; column 7, lines 27-46). However, although Wiser discloses that the string is embedded in the passport linked to the file (column 6, lines 44-46), Wiser does not explicitly disclose also embedding the personal information in the file itself.

Fujiwara discloses a system for content delivery in which personal data is embedded in a delivered digital file (page 4, paragraph 0047; page 5, paragraphs 0049 and 0054). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify the content of Wiser to include the string also embedded directly in the digital file, in order to effectively prevent illegal copying (see Fujiwara, page 5, paragraph 0049).

In reference to Claim 21, Wiser discloses a method including acquiring a digital string, embedding the string in a passport that is linked to the digital file (column 8, lines 53-56), and conveying the file to a purchaser (column 9, lines 54-56). However, although Wiser discloses that the string is embedded in the passport linked to the file (column 6, lines 44-46), Wiser does not explicitly disclose also embedding the personal information in the file itself.

Fujiwara discloses a method for content delivery in which personal data is embedded in a delivered digital file (page 4, paragraph 0047; page 5, paragraphs 0049 and 0054). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify the method of Wiser to include embedding the string directly in the digital file, in order to effectively prevent illegal copying (see Fujiwara, page 5, paragraph 0049).

In reference to Claims 22-24, Wiser further discloses encrypting the digital string (column 9, lines 19-20).

In reference to Claim 25, Wiser further discloses generating a digital watermark (column 7, lines 5-6 and 17-26).

In reference to Claims 26 and 27, Wiser further discloses a provider string that can be encrypted (see column 4, lines 1-4; column 7, lines 27-46; see also column 10, line 60-column 11, line 7).

In reference to Claim 28, Wiser further discloses recording the file on a portable medium (column 9, line 53-column 10, line 16).

In reference to Claims 29 and 30, Wiser further discloses transmitting the content via a network (column 5, lines 43-46).

In reference to Claims 31-33, Wiser further discloses that the string can be embedded in images (column 6, lines 59-60) or audio (column 6, lines 48-52; column 7, lines 4-9). Fujiwara also discloses that the file can include text, images, and audio (for example, page 6, paragraph 0057).

In reference to Claim 34, Wiser further discloses that the latent value of the string resides in information that would place the purchaser at increased financial risk if known by another (column 8, lines 53-56).

In reference to Claim 35, Wiser further discloses determining the content of the string (column 9, lines 11-24).

In reference to Claim 37, Wiser discloses a system including a processor (see, for example, Figure 1, Client System 126; see also column 9, lines 40-52), a storage device (for example, see column 10, lines 50-55), an interface, and content including a digital file (column 6, lines 48-52) and a string embedded in a passport that is linked to the digital file (column 8, lines 53-56). However, although Wiser discloses that the string is embedded in the passport linked to the file (column 6, lines 44-46), Wiser does not explicitly disclose also embedding the personal information in the file itself.

Fujiwara discloses a system for content delivery in which personal data is embedded in a delivered digital file (page 4, paragraph 0047; page 5, paragraphs 0049 and 0054). Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made modify the system of Wiser to include the string also embedded directly in the digital file, in order to effectively prevent illegal copying (see Fujiwara, page 5, paragraph 0049).

In reference to Claim 38, Wiser further discloses an output device (column 10, lines 1-16).

In reference to Claims 39 and 40, Wiser further discloses a connection to a network (column 5, lines 43-46).

In reference to Claim 41, Wiser further discloses determining the content of the string (column 9, lines 11-24).

In reference to Claims 42 and 43, Wiser further discloses a point of sale machine and a network connection (see column 11, lines 8-13).

In reference to Claim 44, Wiser discloses a system including a processor (column 9, lines 40-52), an interface that requests a digital string (column 8, lines 53-56), and a storage device (for example, column 10, lines 50-55). Wiser further discloses embedding the string in a passport that is linked to a digital file (column 8, lines 53-56). However, although Wiser discloses that the string is embedded in the passport linked to the file (column 6, lines 44-46), Wiser does not explicitly disclose also embedding the personal information in the file itself.

Fujiwara discloses a system for content delivery in which personal data is embedded in a delivered digital file (page 4, paragraph 0047; page 5, paragraphs 0049 and 0054). Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made modify the system of Wiser to embed the string directly in the digital file, in order to effectively prevent illegal copying (see Fujiwara, page 5, paragraph 0049).

In reference to Claims 45 and 46, Wiser further discloses a network (column 5, lines 43-46).

16. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dwork et al, US Patent 6038316, in view of Fujiwara.

In reference to Claim 36, Dwork discloses acquiring a digital string (column 7, lines 40-47), embedding the string in an encryption key (column 7, lines 14-19), encrypting a digital file (column 7, lines 34-37), and conveying the encrypted file to a purchaser (column 7, lines 38-40). However, Dwork does not explicitly disclose also embedding the digital string in the digital file that is encrypted.

Fujiwara discloses a method for content delivery in which personal data is embedded in a delivered digital file (page 4, paragraph 0047; page 5, paragraphs 0049 and 0054). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify the method of Dwork to include embedding the string directly in the digital file before encryption, in order to effectively prevent illegal copying (see Fujiwara, page 5, paragraph 0049).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Michel et al, US Patent 5625690, discloses a system for preventing illegal unpaid copying of software that includes embedding sensitive information about the user such as a credit card number into the program in order to deter distribution and allow tracing of illegal distribution (see especially column 8).

b. Iwamura, US Patent Application Publication 2001/0024510, discloses a system for copy protection of digital content that includes embedding personal information as watermarks.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2137

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

zad
zad

Matthew Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137